

Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

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| Applicant's or agent's file reference DA 2832 PCT | FOR FURTHER ACTION | See Form PCT/IPEA/416 |
| International application No. PCT/DE2004/000877 | International filing date (day/month/year) 27.04.2004 | Priority date (day/month/year) 24.06.2003 |
| International Patent Classification (IPC) or national classification and IPC | | |
| Applicant FEDERAL-MOGUL SEALING SYSTEMS GMBH | | |

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| 1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36. |
| 2. This REPORT consists of a total of <u>7</u> sheets, including this cover sheet. |
| 3. This report is also accompanied by ANNEXES, comprising: a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows: <input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions). <input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box. b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions). |
| 4. This report contains indications relating to the following items: <input checked="" type="checkbox"/> Box No. I Basis of the report <input type="checkbox"/> Box No. II Priority <input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability <input type="checkbox"/> Box No. IV Lack of unity of invention <input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement <input type="checkbox"/> Box No. VI Certain documents cited <input checked="" type="checkbox"/> Box No. VII Certain defects in the international application <input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application |

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|---|-----------------------------------|
| Date of submission of the demand | Date of completion of this report |
| Name and mailing address of the IPEA/EP | Authorized officer |
| Facsimile No. | Telephone No. |

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Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language _____ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on (*replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report*):
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-8 _____ as originally filed/furnished
- pages* _____ received by this Authority on _____
- pages* _____ received by this Authority on _____
- ☒ the claims:
- nos. 1-11 _____ as originally filed/furnished
- nos.* _____ as amended (together with any statement) under Article 19
- nos.* _____ received by this Authority on _____
- nos.* _____ received by this Authority on _____
- ☒ the drawings:
- sheets 1/9-9/9 _____ as originally filed/furnished
- sheets* _____ received by this Authority on _____
- sheets* _____ received by this Authority on _____
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages _____
- ☐ the claims, nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (*specify*): _____
- ☐ any table(s) related to sequence listing (*specify*): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

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| Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement | | |
|---|---|-------------|-----|
| 1. Statement | | | |
| Novelty (N) | Claims | <u>11</u> | YES |
| | Claims | <u>1-10</u> | NO |
| Inventive step (IS) | Claims | | YES |
| | Claims | <u>1-11</u> | NO |
| Industrial applicability (IA) | Claims | <u>1-11</u> | YES |
| | Claims | | NO |
| 2. Citations and explanations (Rule 70.7) | | | |
| 1. Reference is made to the following documents: | | | |
| D1: EP-A-1 241 383 | | | |
| (FEDERAL MOGUL SEALING SYS SPA) | | | |
| 18 September 2002 (2002-09-18) | | | |
| D2: EP-A-0 872 671 | | | |
| (NIPPON GASKET KK) | | | |
| 21 October 1998 (1998-10-21) | | | |
| D3: US-A-5 727 791 | | | |
| (ERB WILFRIED ET AL) | | | |
| 17 March 1998 (1998-03-17) | | | |
| 2. The present application does not meet the requirements of PCT Article 33(1) because the subject matter of claim 1 lacks novelty (PCT Article 33(2)). | | | |
| 1. Claim 1: | | | |
| Document D1 discloses in figures 1 and 3 (the references between parentheses refer to that | | | |

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| Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
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document) :

cylinder head gasket (7') for an internal combustion engine, which can be used to seal components (2, 3, 4) that have at least one area that forms at least a T-shaped region (5, 6), said gasket comprising at least one functional layer and at least one spacing layer (7') as well as at least one additional sealing element (10), which is provided in the T-shaped region (5, 6), the spacing layer (7') being provided, at least in the T-shaped region (5, 6), with at least one recessed area (11, 13) for receiving the additional sealing element (10).

2. Document D3 also shows all the features of claim 1 (see figures 1 and 4).

3. Dependent claims 2-11 do not contain any features which, in combination with the features of any claim to which they refer, meet the PCT requirements for novelty and inventive step. The reasons are as follows:

1. Dependent claims 2-10:

D1 discloses all the features of claims 2-10 in figures 1 and 3 and in column 4, line 41 to column 5, line 2.

2. Dependent claim 11:

D2 shows the feature (silicon bead) of this claim in column 9, lines 1 to 4. A person skilled in the art would apply that feature to a cylinder

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Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
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head gasket as per document D1 without thereby
being inventive.

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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

4. Contrary to PCT Rule 5.1(a)(ii), the description does not cite document D1 or indicate the relevant prior art disclosed therein.

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Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

5. The application does not meet the requirements of PCT Article 6 because claims 1-17 are not clear.

1. It is not clear whether the T-shaped region and the components (2, 3, 4) are covered by the scope of protection of, in particular, claims 1 and 2 (see the Guidelines, C-III, 4.8a).

2. Claims 7 and 9:
It is not clear whether the cylinder head gasket is claimed in its mounted or unmounted state.